

**Appl. No. 10/019,650**

**Art Unit 3761**

**December 30, 2004**

**Reply to Office Action of October 5, 2004**

**REMARKS**

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

In the present reply, claims 1-6 have been amended, and new claims 7-9 have been added. Thus, claims 1-9 are pending in the present application.

No new matter has been added by way of these amendments and new claims, because each amendment and new claim is supported by the present specification and/or is editorial in nature. For example, the amendment to claim 1 has support in the present specification in the Figures (e.g., Figure 2 has surface portion 5A with one set of elastic members, and raised portion 5B with the other set) and, e.g., at page 5, lines 5-15 and 15-16 in the written description. The amendments to claims 2-6 are obviously for clarification purposes (e.g., antecedent basis) and are not narrowing in scope. Thus, by clarifying the claimed invention, Applicants are in no way conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents. New claims 7-9 drawn to other embodiments of the present invention have been added for the Examiner's consideration. Support for new claim 7 can be found in the present specification in the Figures and at page 2, lines 17-26; page 5, lines 17-20; and page 6, lines

**Appl. No. 10/019,650**

**Art Unit 3761**

**December 30, 2004**

**Reply to Office Action of October 5, 2004**

12-16. New claim 8 is supported in the present specification at page 5, lines 24-26. Finally, support for new claim 9 can be found in the present specification at page 9, lines 24-27 and at page 4, lines 4-6. Thus, no new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

***Issues Under 35 U.S.C. § 102(e)***

Claims 1, 2 and 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yosioka '023 (U.S. Patent No. 6,156,023). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action at pages 2-3, the Examiner refers Applicants to Figures 2 and 3 and other parts of the cited Yoshioka '023 reference as asserted disclosure of all claimed features. The outstanding rejection is actually maintained for the reasons stated at pages 5-6 of the Office Action. However, Applicants respectfully refer the Examiner to the scope of the disputed claims as presented herein.

**Appl. No. 10/019,650**

**Art Unit 3761**

**December 30, 2004**

**Reply to Office Action of October 5, 2004**

As instantly claimed, the present invention includes elastic members not found in Yoshioka '023. In the present invention, there is a first set of elastic members that are disposed and fixed to the skin-contacting surface portion. Further, the present invention employs a second set of elastic members that are disposed and fixed to the raised portion. The structure associated with the elastic members are described in the present specification at page 5, and one of skill in the art can readily envision and understand such a structure by reviewing the written description and Figures 1 and 2 of Applicants' specification.

In contrast, Yoshioka '023 fails to disclose all instantly claimed features. In the Office Action at pages 5-6, the Examiner relies on Figure 3 of Yoshioka '023 to interpret the "raised portion" as being the area below the skin contacting surface to just below the area showing the folded back side (see the Office Action at page 6, lines 1-8). Thus, the Examiner interprets the Yoshioka '023 structure to have elastic members in the "raised portion".

In response, Applicants respectfully submit that Yoshioka '023 discloses a different embodiment than the present invention. As can be seen from its Figure 3, Yoshioka '023 merely discloses members 24A, 24B and 24C that are simultaneously contacting its

**Appl. No. 10/019,650**

**Art Unit 3761**

**December 30, 2004**

**Reply to Office Action of October 5, 2004**

skin contacting and raised portions. This is in contrast to the separate set of elastic members of the instantly claimed invention.

As can be seen from Applicants' Fig. 2 (see also page 5, lines 12+ of the present specification), the present invention utilizes different elastic members for each of portions 5A (surface that contacts user's skin) and 5B (the raised part). Thus, Yoshioka '023 fails to disclose all features as instantly claimed.

Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Yoshioka '023 reference cannot be a basis for a rejection under § 102(e). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Yoshioka '023 is overcome. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

***Issues Under 35 U.S.C. § 103(a)***

Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshioka '023. This rejection respectfully is traversed to the extent deemed to apply to the claims as amended.

**Appl. No. 10/019,650**

**Art Unit 3761**

**December 30, 2004**

**Reply to Office Action of October 5, 2004**

**Lack of Disclosure of All Claims Features**

Applicants respectfully submit that a *prima facie* case of obviousness has not been formed with respect to the asserted modification of Yoshioka '023, because not all requirements for a *prima facie* case of obviousness have been satisfied. In particular, there is no disclosure of all claimed features as mentioned above. Each of disputed claims 3-5 depends on claim 1, wherein claim 1 is directed to using the two sets of elastic members. Thus, Applicants submit that this rejection under § 103(a) has been overcome, since U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); see also *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Here, not even the first requirement of disclosure of all claimed

**Appl. No. 10/019,650**

**Art Unit 3761**

**December 30, 2004**

**Reply to Office Action of October 5, 2004**

features has been satisfied, since the cited Yoshioka '023 reference merely discloses members 24A, 24B and 24C that are simultaneously contacting its skin contacting and raised portions. Such a disclosure in Yoshioka '023 is in contrast to the instantly claimed invention which employs the two sets of elastic members. Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been established, and that this rejection has been overcome. Withdrawal of this rejection is respectfully requested.

**Inoperability: Lack of Motivation and/or Reasonable Expectation of Success**

Applicants also submit that the other requirements for a *prima facie* case of obviousness have not been satisfied.

Yoshioka '023 requires that its elastic members 24 be in contact with sealing surface zone 20 and simultaneously in contact with sections 17, 18 and 16 (see its Figure 3 and column 3, lines 13-22). Thus, modifying the Yoshioka '023 embodiment in order to achieve the present invention would destroy the function or workability of the Yoshioka '023 embodiment. In this regard, Applicants note that if a proposal for modifying the cited reference in an effort to attain the claimed invention causes the reference to become inoperable or destroys its intended function,

**Appl. No. 10/019,650**

**Art Unit 3761**

**December 30, 2004**

**Reply to Office Action of October 5, 2004**

then the requisite motivation to make the modification would not have existed. See *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) (Federal Circuit stating that modifying the French apparatus as the Board suggested would render the apparatus inoperable for its intended purpose); *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); see also *In re Ratti*, 123 USPQ 349, 352 (CCPA 1959). That is the case here because the present invention would destroy the intended purpose of the cited Yoshioka '023 reference. Thus, Applicants submit that the requisite motivation is lacking.

Further, the requisite reasonable expectation of success is lacking since one of ordinary skill in the art would not reasonably expect to be successful, upon reading Yoshioka '023, in achieving the presently claimed invention when that skilled artisan has to change the key structure in Yoshioka '023. Thus, Applicants submit that the requisite reasonable expectation of success is further lacking.

Accordingly, Applicants respectfully submit that the instant rejection under § 103(a) has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

### **Conclusion**

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial

**Appl. No. 10/019,650**

**Art Unit 3761**

**December 30, 2004**

**Reply to Office Action of October 5, 2004**

steps in efforts to advance prosecution of the present application.

Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By



John W. Bailey, #32,881

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

JWB/ETP  
0445-0316P